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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,373	12/22/2000	Victor L. Dorff	DORFF.001A	8368
20995	7590	07/14/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/749,373	DORFF ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Lalita M Hamilton	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 20040712.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-2 are objected to because of the following informalities: In claim 1, after "institution", the semicolon should be a comma. In claim 2, after "charity", the semicolon should be a comma. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 and 9-14 are rejected for the following reasons:

In claim 1, "name", "reverse side", and "checks" lack antecedent basis.

In claim 2, "name" and "reverse side" lack antecedent basis.

In claim 3, "identity" lacks antecedent basis.

In claim 9, "identity", "payee", "drawee", and "payor's bank account" lack antecedent basis.

Claims 10-12 are rejected for their dependency upon claim 9.

In claim 13, "back side" lacks antecedent basis.

In claim 14, "side" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added).

Claims 1 and 3-12 are rejected under 35 U.S.C. § 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to over come the 101 rejection above, the following preamble is suggested:  
"A computer implemented method for ---", or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented.

Claim 2, claims a system. However, the preamble and the body of the claim do not indicate that the system is may be executed on a computer. Appropriate correction is required.

In order to over come the 101 rejection above, the following preamble is suggested:  
"a system executed using a computer ---", or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer executable.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz (5,801,365).

Katz discloses a fund raising method and corresponding system utilizing special issue checks comprising issuing to consumers a negotiable philanthropy check having a fixed monetary value, the payor of said check being a charitable institution, filling in by the consumer or by any recipient who receives the philanthropy check originally issued to said consumer, the name of a second charitable institution as drawee of said philanthropy check, and comparing the identity of said drawee with a list of qualified charities before the philanthropy check is honored by the drawee of said philanthropy check (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); issuing to consumers a negotiable philanthropy check having a fixed monetary value, the payor of said check being a charitable institution and filling in by the consumer or by any recipient who receives the philanthropy check originally issued to said consumer, the name of a second charitable institution as drawee of said philanthropy check (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); comparing the identity of the payee of a philanthropy check said drawee with a list of qualified charities before the philanthropy check is honored by the drawee of said philanthropy check and funds are

withdrawn from the payor's bank account (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); comparing is performed by both the payor and the drawee (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); comparing is substantially performed by the payor (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); comparing is substantially performed by the drawee (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); a printed document having: a face value in U.S. dollars, the name of a qualified charity as payor; the name of a drawee bank, a blank line to be filled in as payee, a notice on the back side of the check that the check must not be presented for payment by other than a qualified charitable institution, and a notice on the front side of the check that the transfer of the check to a qualifying charity is not a charitable contribution (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); and a printed document having a face value in U.S. dollars, the name of a qualified charity as payor; the name of a drawee bank, a blank line to be filled in as payee, and a notice on the side of the check that the check must not be presented for payment by other than a qualified charitable institution (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all). It is inherent that the checks may be used as incentive awards, as part of an educational instruction on the importance of charitable giving, as point of sale items, or distributed using the Internet, since many methods may be utilized to manage, promote, and teach multiple levels of charitable giving.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Alcordo (5,566,981).

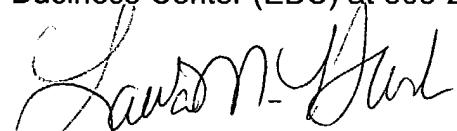
Katz discloses a fund raising method and corresponding system utilizing special issue checks comprising printing a philanthropy negotiable check having (a) a face value in U.S. dollars, (b) the name of a charitable institution as payor, (c) the name of said payor's bank as drawee, (d) a blank line to be filled in as payee, and (e) a notice on the reverse side that the check must not be presented for payment by any entity that is not a qualified charitable institution, distributing said philanthropy check to contributors to said charitable institution, distributing said philanthropy checks by said contributors to any third party recipient through one or more levels of gift giving, entering by said third party recipient the name of any qualified charitable institutions as payee of said philanthropy check, delivering said philanthropy check to said payee charitable institution, depositing said philanthropy checks in a bank by said payee qualified charitable institution, confirming that said payee is a qualified charitable institution, and transferring funds from said payor institution bank to said recipient qualified charitable institution after the payee has been confirmed to be a qualified charitable institution (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all); and a

philanthropy check on which is printed (a) the name of a charitable institution as payor and (b) the name of said institution's bank as drawee, (c) a blank line to be filled in with the name of the payee, and (d) a notice on the reverse side of the check that the check must not be presented for payment by an entity that is not a qualified charity, first means for comparing the name of the payee with an abbreviated list of qualified charities, and second means for comparing the name of the payee with complete list of qualified charities if said first means fails to locate the name of the payee on said abbreviated list of qualified charities (col.3, line 35 to col.4, line 14; col.5, line 40 to col.6, line 44; and fig.2-all).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH